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In re Application of:
SILVERBROOK, Kia
U.S. Application No.: 10/510,094
PCT No.: PCT/AU02/01161
International Filing Date: 29 August 2002
Priority Date: 24 June 2002
Atty Docket No.: BAL20US
For: PHOTOGRAPHIC PRINTS HAVING
MAGNETICALLY RECORDED
MEDIA

DECISION ON PETITIONS

This decision is issued in response to applicant's petition to withdraw the holding of abandonment, filed 23 May 2005 (treated herein under 37 CFR 1.181), and the petition for revival under 37 CFR 1.137(b) filed 30 May 2006. No petition fee is required for the petition under 37 CFR 1.181, and applicant has submitted the petition fee required for the petition under 37 CFR 1.137(b).

BACKGROUND

On 29 August 2002, applicant filed international application PCT/AU02/01161. The international application claimed a priority date of 24 June 2002, and it designated the United States. On 31 December 2003, the International Bureau (IB) communicated a copy of the international application to the United States Patent And Trademark Office (USPTO). The deadline for payment of the full basic national fee was thirty months from the priority date, i.e., 24 December 2004.

On 05 October 2004, applicant filed a transmittal letter requesting entry into the national stage in the United States. The transmittal letter was accompanied by, among other materials, a check in the amount of \$1,080 and an executed declaration.

On 21 April 2005, the United States Designated/Elected Office (DO/EO/US) mailed a Notification Of Abandonment (Form PCT/DO/EO/909) indicating that the application was abandoned for failure to provide the full U.S. basic national fee before the expiration of thirty months from the priority date.

On 23 May 2005, applicant filed the petition to withdraw the holding of abandonment considered below as a petition under 37 CFR 1.181. The petition seeks withdrawal of the

holding of abandonment based on applicant's inclusion of the \$1,080 fee payment in the 05 October 2004 submission.

On 30 May 2006, applicant filed the petition for revival of an unintentionally abandoned application under 37 CFR 1.137(b), also considered below.

DISCUSSION

1. Petition Under 37 CFR 1.181:

The materials initiating the present national stage application were filed on 05 October 2004. These materials included a check in the amount of \$1,080 (\$1,040 for the U.S. basic national fee and \$40 as the fee for recording an assignment). As of the filing date of the national stage papers, the applicable U.S. basic national fee was \$1,110; applicant's 05 October 2004 fee payment was therefore not sufficient to meet the full U.S. basic national fee.

Pursuant to 37 CFR 1.495(h), an international application becomes abandoned with respect to the U.S. if the full basic national fee is not submitted prior to the expiration of thirty months from the priority date. Here, as noted above, applicant's 05 October 2004 fee payment of \$1,080 did not include the full U.S. basic national fee applicable as of 05 October 2004. However, the applicable basic national fee for this application was reduced to \$300 as of 08 December 2004, prior to the expiration of thirty months from the priority date (i.e., 24 December 2004). Because the USPTO was in receipt of the full applicable basic national fee prior to the expiration of thirty months from the priority date, abandonment of this application was improper.

The Notification Of Abandonment mailed 21 April 2005, based as it was on applicant's purported failure to submit the full basic national fee prior to the expiration of thirty months from the priority date, is therefore appropriately vacated.

2. Petition For Revival Under 37 CFR 1.137(b):

Based on the withdrawal of the holding of abandonment discussed above, applicant's petition for revival of the application under 37 CFR 1.137(b) filed 30 May 2006 is moot,

The \$1530 in petition fees filed with this petition will be refunded to applicant.

It is noted that applicant's 05 October 2004 submission included an executed declaration in compliance with 37 CFR 1.497.

CONCLUSION

The petition for withdrawal of the abandonment under 37 CFR 1.181, filed 23 May 2005, is **GRANTED**.

The Notification Of Abandonment (Form PCT/DO/EO/909) mailed 21 April 2005 is hereby vacated.

The petition for revival under 37 CFR 1.137(b), filed 30 May 2006, is **DISMISSED AS MOOT**.

The \$1,530 in fees submitted with the petition for revival filed 30 May 2006 will be refunded to applicant.

This application is being referred to the National Stage Processing Division of the Office of PCT Operations for further processing in accordance with this decision. The date under 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) is 08 December 2004.



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